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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,446	02/06/2002	Charles E. Romano JR.	82840LMB	9544

7590

04/08/2004

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/068,446

Applicant(s)

ROMANO ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-22,24,25 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) 14-17,22,24,25 and 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-13 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's response filed on 01/09/2004 has been fully considered. All previous rejections have been withdrawn in view of Applicant's amendments and comments.

2. Claims 1, 3, 6-9, 22, 27 and 28 are amended, claims 2, 5, 23 and 26 are cancelled, and thus claims 1, 3, 4, 6-22, 24, 25 and 27-29 are pending. (NOTE: Claims 14-17, 22, 24, 25 and 27-29 are withdrawn from consideration as non-elected invention).

### ***Election/Restrictions***

3. Applicant's election with traverse of Group I, Species A, claim 1-13 and 18-21 in Paper No. 20040109 is acknowledged. The traversal is on the ground(s) that searching of the two groups would not prove seriously burdensome to the Examiner. This is not found persuasive for at least the following reason. A search for the first group is conducted in class 428, and a search for the second group is conducted in class 347. Searching in two different areas put a serious undue burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 6-11, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tang et al. (WO 00/53406) in view of Peternell et al. (US 6,420,016).

Tang discloses an ink jet receiving medium having a gelatin containing ink receiving layer (page 1, line 4). The source of the gelatin can be animal skin or bones. Animal skin also includes pigskin (see Peternell col. 4, line 3). Acid or alkaline processed gelatin, and gelatin derivatives such as phthalated, acetylated, carbamoylated, and succinated gelatin can be used for this application. Different types of gelatin can be used in combination. The strength is preferably in the range of 150-350 bloom. See page 11, lines 3-9. Mordant is added to the ink receiving layer to improve water resistance of the printed image (page 11, line 14). The ink jet receiving medium further comprises an overcoat layer on the top of the ink receiving layer (claim 20). The ink receiving layer further comprises hydrophilic polymer (Table 1).

With respect to claim 9, Tang fails to disclose the amount of each type of gelatin when using combination of different types of gelatin. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the content of different types of the gelatin to optimize ink drying time, water resistance and durability of the ink receiving layer. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

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With respect to the claimed laminate adhesion property, the combination of Tang and Peternell teaches an article substantially identical to the claimed article, thus the article functions in the same manner as the claimed article.

6. Claims 1, 3, 4, 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poerschke (DE 197 21 238 A1) in view of Peternell et al. (US 6,420,016 B1).

Poerschke discloses an ink jet recording medium comprising an ink receiving layer containing modified gelatin (claim 1). The source of the gelatin is bone or skin (page 2, last paragraph). Skin also includes pigskin (see Peternell col. 4, line 3). The gelatin is modified with alkylene succinic acid, wherein the alkylene group has 8-25, preferably 8-16 carbon atoms. Dodecenylsuccinic acid is a preferred example. See page 3, 3<sup>rd</sup> full paragraph. Since the gelatin used in the prior art is substantially identical to the gelatin used in the current application, the gelatin of the prior art inherently possesses the claimed bloom strength.

With respect to the claimed laminate adhesion property, the combination of Poerschke and Peternell teaches an article substantially identical to the claimed article, thus the article functions in the same manner as the claimed article.

7. Claims 1, 10-13, 18, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peternell et al. (US 6,420,016) in view of Tang et al. (WO 00/53406).

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Peternell discloses an ink jet recording sheet comprising a support, a gelatin containing absorption layer on the support, and an ink receiving layer on the absorption layer (col. 3, line 14). The source of gelatin is pigskin or bone. Gelatin derivative such as phthalaoylated, acetylated or carbamoylated gelatin can be used (col. 4, line 1). The use of succinated gelatin is taught in page 11 lines 3-9 of Tang. The absorption layer further comprises hydrophilic polymer such as polyvinyl alcohol (col. 4, line 12). Since the gelatin used in the prior art is substantially identical to the gelatin used in the current application, the gelatin of the prior art inherently possesses the claimed bloom strength. The ink receiving layer is equivalent to the claimed overcoat layer. The ink receiving layer comprises cellulose ether such as hydroxyethyl cellulose and carboxymethyl cellulose (col. 4, line 67), and/or vinyl latex such as copolymer of vinyl monomer and (meth)acrylamide (col. 5, line 16).

With respect to the claimed laminate adhesion property, the combination of Peternell and Tang teaches an article substantially identical to the claimed article, thus the article functions in the same manner as the claimed article.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 3, 4, 6-13 and 18-21 have been considered but are moot in view of the new ground(s) of rejection.

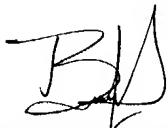
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***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Betelhem Shewareged  
April 4, 2004.